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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,436	08/01/2003	Michael F. Thomashow	21835-00004	3828

27144 7590 10/17/2006

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EXAMINER

KUMAR, VINOD

ART UNIT PAPER NUMBER

1638

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/632,436	THOMASHOW ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vinod Kumar	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 9-12, 17 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) 9, 11 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____  | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The objection to specification is withdrawn. But the amendment directs replacement of the wrong paragraph. The correct replacement paragraph number 000149 was confirmed in a telephonic call to Mitchell Jones (Reg. No. 44,174) on September 11, 2006.
3. The rejection of claims 12 and 20-25 under 112, second paragraph is withdrawn in light of claim amendments.
4. The rejection of claims 12 and 20-24 under 112, first paragraph is withdrawn in light of claim amendments.
5. Claims 12 and 20-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 12 recite "95%" which introduces **NEW MATTER** into amended claims. The specification does not provide written description support for sequences that are at

least 95% homologous to SEQ ID NO: 1. This does not comply with written description requirements.

6. Claim 12 remain and new claims 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Harper et al. (US Patent Publication No. 2002/0160378; filed August 24, 2001) for the reasons of record stated in Office actions mailed on March 21, 2006. Applicants traverse the rejection in the paper filed July 27, 2006.

Applicants argue that Harper et al. do not teach the use of SEQ ID NO: 1 of the instant application. SEQ ID NO: 2316 in table 7 of the reference is identified as being saline stress responsive sequence. Harper et al. do not teach the use of SEQ ID NO: 2316 to induce freezing and drought tolerance (response, page 8, 12-18). Furthermore, the claims are not directed to the composition, the claims are properly directed to a process limited to the new use discovered by Applicants and Examiner's anticipation by inherency fails to take into account the limitation to the newly discovered use (response, page 9, lines 27-30).

Applicants arguments were fully considered but were not found persuasive. Examiner maintains that paragraph 0031 of Harper et al. clearly teach that SEQ ID NO: 2316 would confer any type of stress tolerance that includes cold and dehydration related stresses. Furthermore, the property of regulating cold and dehydration genes is inherent to the method used by Harper et al. as SEQ ID NO: 2316 (100% identical to instant SEQ ID NO: 1) encodes a protein that has the inherent property of binding to CAACA regulatory sequence of cold and dehydration genes. Furthermore, Harper et al. method steps for regulating any stress related genes including cold and dehydration genes in a plant using SEQ ID NO: 2316 are identical to the instant method steps of

regulating cold and dehydration regulatory genes in a plant using SEQ ID NO: 1. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, rather than any distinct definition of any of the claimed invention's limitations, then preamble is not considered a limitation and is of no significance to claim construction. See MPEP 2111.02. Also see *In re Cruciferous Sprout Litig.*, 301 F.3d 1343,1346-48, 64 USPQ2d 1202, 1204-05 (Fed. Cir. 2002) where a claim at issue was directed to a method of preparing a food rich in glucosinolates wherein cruciferous sprouts are harvested prior to the 2-leaf stage. The court held that the preamble phrase "rich in glucosinolates" helps define the claimed invention, as evidenced by the specification and prosecution history, and thus is a limitation of the claim (although the claim was anticipated by prior art that produced sprouts inherently "rich in glucosinolates"). Furthermore, see *Integra LifeSciences I Ltd. V. Merck KGaA* 50 USPQ2d 1846, 1850 (DC Scalif 1999), which teaches that where the prior art teaches all of the required steps to practice the claimed method and no additional manipulation is required to produce the claimed result, then prior art anticipates the claimed invention.

Accordingly, rejection is maintained.

### **Summary**

7. Claims 12 and 20-25 are rejected, claims 9, 11 and 17 are withdrawn.
8. Applicants amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §

Art Unit: 1638

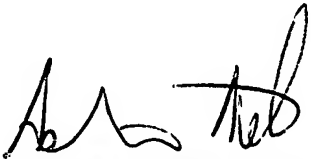
706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is set to expire within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinod Kumar whose telephone number is (571) 272-4445. The examiner can normally be reached on 8.30 a.m. to 5.00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ASHWIN D. MEHTA, PH.D.  
PRIMARY EXAMINER